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08/317,407	10/03/94	CARLING	C 1103326018

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WHITE & CASE
PATENT DEPARTMENT
1155 AVENUE OF THE AMERICAS
NEW YORK NY 10036

HENLEY EXAMINER	
ART UNIT	PAPER NUMBER
	#25

1205
DATE MAILED:

10/07/96

10/07/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.
08/317,407

Applicant(s)
Christer C. G. Carling, et al.

Examiner
Ray Henley

Group Art Unit
1205



☒ Responsive to communication(s) filed on Sep 3, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 2, 7, 14-18, and 20-28 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1, 2, 7, 14-16, and 24-26 is/are allowed.

☒ Claim(s) 17, 18, 20-23, 27, and 28 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 24

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1205

CLAIMS 1, 2, 7, 14-18 AND 20-28 ARE PRESENTED FOR EXAMINATION

Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.129(a). Applicants' first submission after final filed on September 3, 1996 has been entered. Accordingly, claims 1, 2, 7, 17, 20, 22 and 23 have been amended; claim 19 has been cancelled; and claims 24-28 have been added.

Also, the Information Disclosure Statement filed with the above submission has been received and, as reflected by the attached, completed copies of form PTO-1449, the cited references have been considered.

In view of applicants' amendments, claims 1, 2, 7, 14-16 and 24-26 are allowable because the range of molar ratios recited therein are consistent with the ranges for which unexpected results have been demonstrated. Applicants may wish to consider amending claims 1, 2 and 7 to recite that the lower molar ratio is "1:1" rather than the presently recited "1:4" because as evinced in the declaration of Dr. Trofast filed June 12, 1995, applicants are entitled to this broader, lower limit of the molar ratio range.

Claims 17, 18, 20-23, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brattsand et al. and Murakami et al. in view of applicants' acknowledgments at

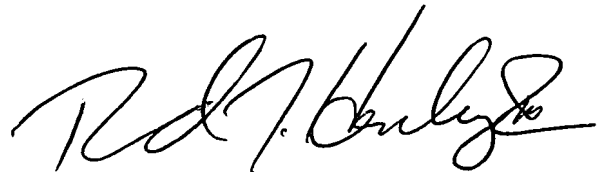
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page 3 of the present specification for the reasons of record as maintained in the Advisory Action dated February 21, 1996.

Applicants' arguments have been carefully considered, but fail to persuade the Examiner of error in his determination because claim 17 is not limited to the molar ratio range for which unexpected results have been demonstrated, i.e., the molar ratio of the formoterol component to the budesonide component being in the range of from 1:1 to 1:60. Thus, because the claims encompass ratios at which unexpected results have not been demonstrated, such ratios remain to be presumed to have been obvious as producing no more than additive results which would have been expected by the skilled artisan.

Accordingly, claims 17, 18, 20-23, 27 and 28 are properly rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ray Henley whose telephone number is (703) 308-4652.



Henley; rjh
September 15, 1996

RAYMOND HENLEY, III
PRIMARY EXAMINER
GROUP 1200